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09/996,720	11/30/2001	Andrew M. Spencer	10014185-1	4492

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EXAMINER

CHACE, CHRISTIAN

ART UNIT	PAPER-NUMBER
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2187

4

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/996,720

Applicant(s)

SPENCER ET AL.

Examiner

Christian P. Chace

Art Unit

2187

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

This Office action has been issued in response to amendment filed 23 July 2003. Claims 1-27 are pending. Applicants' arguments have been carefully and respectfully considered, but they are not persuasive. Accordingly, this action has been made FINAL, as necessitated by amendment.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim recites, "...number of times data was corrected by the memory card." Although correcting data is literally recited, there is no explanation to enable one to make and/or use the recited matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. See supra.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu et al (US Patent Application Publication #2002/0107832).

With respect to claims 1 and 16, a method and system for storing memory card usage information on a memory card, comprising collecting information about the usage of the memory card, recording the usage information in an area of the memory card, and accessing the information about usage is disclosed in paragraph 15. "Usage information" may be the number of times a website is accessed or the advertising usage disclosed therein.

With respect to claim 2, figure 4 discloses monitoring content reproduced (write events), websites (read events) and power-on events, which are inherent in that if the card records each transaction as discussed in paragraph 2 of Shimizu et al, then the card must be powered on for each of those transactions, and by keeping count of the transactions, power-on events are also inherently "monitored."

With respect to claim 3, the collecting step comprising changing a count associated with an event descriptor when the event occurs is disclosed in figure 9, #S1205.

With respect to claim 4, the collecting step further comprising storing a "value parameter" associated with said event descriptor when the event occurs is disclosed in figure 4 as the "number of times."

With respect to claim 5, the collecting step comprising changing a running total, or count, associated with said event descriptor when the event occurs is disclosed in figure 6 as the number of times reproduction is possible.

With respect to claim 6, recording the information about usage in a dedicated area in said memory card is disclosed in figure 4.

With respect to claim 7, recording the information about usage in a "non-user accessible area" of memory is disclosed in figure 4, and further discussed in paragraph 61 as requiring input by a clerk. As applicants have not discussed which memory the "information about usage" might be stored in, examiner interprets the memory accessible by the clerk, a "non-user," as that memory. Alternatively, it could be interpreted as the clerk's memory itself. Either interpretation is anticipated by applicants' claim language as it stands instantly.

With respect to claim 8, changing a count associated with an event description when the event occurs, and wherein the accessing step comprises displaying the count is disclosed in figure 4, and the "displaying" is discussed in paragraph 59.

With respect to claim 9, a plurality of event descriptors, wherein said accessing step comprises displaying a plurality of the event descriptors (not all of them), wherein each of the displayed plurality of event descriptors is “selectable,” so that [up]on “selection,” additional usage information will be displayed that is associated with the selected event descriptor is disclosed in paragraphs 59 through 61.

With respect to claim 10, the “displaying” step being performed at a “host” is disclosed in paragraph 61, as, “by a clerk.”

With respect to claim 11, displaying real-time information about usage in a window on a screen at a host is disclosed in paragraph 61 as well.

With respect to claim 12, creating “write and read commands” allowing the host to store the information about usage and read that information is disclosed in paragraph 61.

With respect to claim 13, changing a count associated with an event descriptor when the event occurs, and further comprising the steps of comparing the count to a threshold, and if the threshold is equaled or exceeded, then causing a message to be sent is disclosed in paragraph 13, with the “message to be sent” being the targeted advertising.

With respect to claim 14, computer readable storage containing at least one event descriptor about the usage of the memory card, and for each event descriptor, a count representing the number of occurrences of that event is disclosed in figure 4.

With respect to claim 15, an amount of memory used by an aggregation of events corresponding to respective each of the event descriptors (see supra) is inherent – if data of any kind is to be saved, there must be a place to save it.

With respect to claim 17, collecting information about usage activity of a portable memory card in an electronic device and recording the information about usage activity on the memory card itself is disclosed in paragraph 0061.

With respect to claim 19, the collecting information further comprising counting is disclosed in paragraph 0002.

With respect to claim 20, collecting information further comprising counting a number of times an image file was written to the memory card is disclosed in paragraph 0002.

With respect to claim 21, the collecting information further comprising counting a number of times music files (audio data) were written to the memory card is disclosed in paragraph 0002.

With respect to claim 22, the collecting information further comprising tracking a number of times the memory card is formatted is disclosed in paragraph 0061. This is inherent in that the card in paragraph 0061 is formatted <sup>when</sup> use conditions are input by the clerk. Therefore, the format changes, so does the billing information, which is inherently “tracked.”

Claims 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Himoto et al (US Patent #6,478,679).

With respect to claim 23, examiner must first point out that “storing the usage activities on the memory card” has been interpreted as storing the usage activities in the memory of the card. Also, “usage activity” is very broad, and may comprise any number of things. In this case, examiner has interpreted “usage activity” as the type of games stored and the respective scores, for example, as shown in figure 7, 8A, and 8B. These figures also show a portable memory card, as discussed in the abstract. As storing the usage activities is shown as discussed supra, inherently those activities are “monitored” if they are stored. For example, the score is recorded with the game title stored. Displaying the usage activity on the memory card is shown in figure 3 as a LCD. This is also discussed in the abstract, for example. Examiner may also have interpreted “on” to be “about,” or “regarding.” Examiner strongly suggests applicants more clearly claim their invention in light of the many interpretations of same the instant claims conjure.

With respect to claims 24-25, displaying the usage activity IN a window on the memory card or on a screen on the memory card are disclosed, as discussed supra, in figures 7 and 8.

With respect to claim 26, monitoring the amount of remaining free space on the memory card is disclosed in figures 5 and 6.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al (cited supra) and Bueno (US Patent # 5,532,689).

Shimizu et al disclose the subject matter of the claims upon which the instant claim depends.

Shimizu et al disclose collecting information.

The difference between Shimizu et al and the instant claim is the information collected further comprising counting physical insertions of the memory card in the electronic device.

Bueno discloses counting the number of times a memory card is inserted into an electronic device in the abstract as an access count.

Accordingly, it would have been obvious to one of ordinary skill in the art having the teachings of Shimizu et al and Beuno before him/her, to utilize the access counting of Bueno in the system of Shimizu et al as the access counting allows fraud prevention, as discussed by Bueno in column 3, lines 20-25.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Himoto et al (cited supra) and No (US Patent #6,587,140).

Himoto et al disclose the subject matter of the claims upon which the instant claim depends.

Himoto et al disclose providing a portable memory card in a digital video game system.

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The difference between Himoto et al and the instant claim is the memory card being in a digital camera.

No discloses a memory card for use in a digital camera.

Accordingly, it would have been obvious to one of ordinary skill in the art having the teachings of Himoto et al and No before him/her, to utilize the portable memory card of Himoto et al in the camera of No as it allows for a completely portable, untethered camera design, as disclosed by No in column 1, lines 40-43.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 17 and 23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 17 and 21 of copending Application No. 10/052,098. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 17 and 23 are directed to the same invention as that of claims 17 and 21 of commonly assigned application No. 10/052,098. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

### ***Response to Arguments***

With respect to applicants' argument that Shimizu et al do not disclose collecting information about usage of the memory card, examiner respectfully disagrees. Paragraph 0061 discusses the generation of use condition information and the billing information being recorded in the control information storage unit #726, which, as applicants can see in figure 1, is the removable medium. That is the use condition information of the memory card.

Examiner strongly encourages applicants to review the additional cited prior art of record in this case, which examiner finds to be extremely relevant to applicants' claimed invention.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

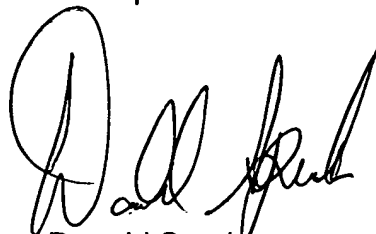
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian P. Chace whose telephone number is 703.306.5903. The examiner can normally be reached on 9-4-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Sparks can be reached on 703.308.1756. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

Christian P. Chace  
DS/cpc



Donald Sparks  
SPE, 2187